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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,086	09/09/2003	Carlo Dall'Aglia	M1885.0035/P035-B	9161
24998	7590	03/19/2004		
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			EXAMINER	
2101 L STREET NW			GONZALEZ, MADELINE	
WASHINGTON, DC 20037-1526			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/657,086	Applicant(s) <input checked="" type="checkbox"/> DALL'AGLIO ET AL.	
	Examiner Madeline Gonzalez	Art Unit 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/678,379.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09 September 2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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2. Claims 21 and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,643,943. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,643,943 discloses in claims 1 and 2 an apparatus for checking a crankpin, orbitally rotating about a geometrical axis, in the course of the machining in a numerical control grinding machine including a worktable, defining said geometrical axis, and a grinding-wheel slide carrying a grinding-wheel, the apparatus including:

- a Vee-shaped reference device for cooperating with the crankpin to be checked;
- a measuring device movable with the Vee-shaped reference device;
- a support device for supporting the Vee-shaped reference device and the measuring device, the support device having:
  - a support element fixed to the grinding-wheel slide;
  - a first coupling element coupled to the support element so as to rotate about an axis of rotation parallel to said geometrical axis;
  - a second coupling element carrying the Vee-shaped reference device and coupled to the first coupling element so as to rotate with respect to it about a second axis of rotation parallel to said geometrical axis;
- a control device for controlling automatic displacements of the apparatus from a rest position to a checking condition, and vice versa;
- a guiding mechanism, associated with the Vee-shaped reference device for guiding the arrangement of the latter on the crankpin towards said checking condition of the apparatus, and including a limiting device with an elongate rigid element arranged

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along a direction substantially parallel to the first coupling element and adapted to cooperate with elements connected to the grinding-wheel slide and the second coupling element, the limiting device including at least one pair of mechanical abutting surfaces adapted to engage with each other and limit movements of the Vee-shaped reference device during said automatic displacements towards the checking condition; and

- wherein the Vee-shaped reference device is adapted for maintaining contact with the crankpin to be checked substantially owing to the forces of gravity.

3. Claims 21 and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 6, 13, 17, 18 and 20 of U.S. Patent No. 6,430,832. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,430,832 discloses in claims 1, 2, 6, 13, 17, 18 and 20 the following limitations:

- a Vee-shaped reference device;
- a measuring device movable with the Vee-shaped reference device;
- a support device having a support element fixed to a grinding-wheel slide;
- a first coupling element coupled to the support element so as to rotate about an axis of rotation parallel to a geometrical axis;

- a second coupling element carrying the Vee-shaped reference device and coupled to the first coupling element so as to rotate with respect to it about a second axis of rotation parallel to said geometrical axis;
- a control device;
- a guiding mechanism associated with the Vee-shaped reference device and including a limiting device with an elongate rigid element arranged along a direction substantially parallel to the first coupling element, the limiting device including at least one pair of mechanical abutting surfaces; and
- wherein the Vee-shaped reference device maintains contact with the crankpin to be checked substantially owing to the forces of gravity.

With respect to the term “ adapted to ” in claim 21: The term “ adapted to ” makes what follows a functional statement and not a positive limitation because it has been held that the recitation that an element is “ adapted to ” perform a function only requires the ability to so perform. It does not constitute a limitation in any patentable sense. See *In re Hutchinson*, 69 USPQ 138.

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***Allowable Subject Matter***

4. The following is a statement of reasons for the indication of allowable subject matter in case a terminal disclaimer is timely filed:

Claim 21 will be allowed because the prior art of record does not disclose or suggest an apparatus for checking a crankpin, said apparatus including a guiding mechanism, associated with a reference device, said guiding mechanism including a limiting device with an elongated rigid element arranged along a direction substantially parallel to a first coupling, said limiting device having at least one pair of abutting surfaces, in combination with the remaining limitations in the claim.

Claim 22 will be allowed due to its dependency on claim 21.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeline Gonzalez whose telephone number is (571) 272-2243. The examiner can normally be reached on Monday-Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MG



Diego F.F. Gutierrez  
Supervisory Patent Examiner  
Technology Center 2800